

Remarks

Claims 1-13 are currently pending in this application.

The Office Action rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Pursley (U.S. Patent No. 6,364,421) in view of McKay (U.S. Patent Application Pub. No. 2003/0154569).

By this Amendment, Applicants have corrected some minor informalities in claims 2 and 5. Applicants respectfully traverse the Section 103(a) rejection of claims 1-13, for the following reasons.

The present invention recited in, for example, claim 1, and claims 2-13 at least by virtue of dependence, comprises a combination of elements, including a wheel balancing device comprising, *inter alia*, an elongate backing strip having a top surface removably attached to the bottom surface of said tape, said backing strip having a plurality of transverse serrations that form lift tabs to facilitate removing said backing strip from said tape.

Pursley discloses a wheel balancing device comprising a backing strip 50 which is wider than the weights to form a gripping surface 52. The Office Action admits that Pursley fails to disclose a backing strip having a plurality of transverse serrations that form lift tabs to facilitate removing the backing strip.

McKay discloses a lint removal apparatus with a pull tab for adhesive coated sheets. McKay is not remotely related to wheel balancing devices. Rather, McKay addresses the need for improved devices and methods for simple cleaning duties such as removing lint, pet hair, and dandruff from clothing or floors.

Thus, McKay is not analogous prior art and, therefore, is not properly combined with Pursley.

“[T]wo criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Clay*, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992). The lint removal apparatus of McKay is clearly not in the same field of endeavor as Pursley—a wheel balancing device. McKay addresses the need for improved devices and methods for simple cleaning duties such as removing lint, pet hair, and dandruff from clothing or floors. In contrast, the present invention addresses the need for adhesive wheel balancing weights that eliminate waste caused by contaminated adhesive, enables individual weights to be separated quickly and easily, without a cutting tool, and permits the backing strip to be quickly and easily removed from the adhesive tape. Surely one of ordinary skill in the wheel balancing device art would not look to the lint removal apparatus art for solutions to the problems addressed by the present invention.

Furthermore, Applicants believe that the Office Action used impermissible hindsight to justify the combination of Pursley and McKay. There is no disclosure in either Pursley or McKay suggesting that these references may be combined. This alone makes the obviousness rejection improper. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984) (obviousness cannot be established by combining the teachings of the prior art to produce the claimed inventions, absent some teaching, suggestion or incentive supporting the combination). The Federal Circuit strongly reiterated this point in *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). In *Sang Su Lee*, the Court held that the PTO must give full reasoning as to what motivation or teaching in the prior art would suggest combining references

relied upon in an obviousness rejection; and that an Examiner's general common knowledge and common sense do not substitute for the authority required by law to reject a claim for obviousness.

Without a motivation to combine these references, the Office Action relies upon the generalized statement "it would have been obvious to provide backing strip of the balance weight strip of Pursley with [sic] serrations to allow easier removal of the backing strip at the location of the break in the weights, and further provide a tab to assist in grasping the backing strip for removal", in an attempt to combine the references. There is nothing in these references suggesting a wheel balancing device comprising, *inter alia*, an elongate backing strip having a top surface removably attached to the bottom surface of said tape, said backing strip having a plurality of transverse serrations that form lift tabs to facilitate removing said backing strip from said tape, without reference to the present application. Thus, the Office Action's assertions merely represent the Examiner's general common knowledge and common sense. Such common knowledge and common sense cannot substitute for the authority required by law to reject a claim for obviousness.

In light of this and the nonanalogous nature of McKay, Applicants respectfully assert that Pursley and McKay are not properly combinable. Applicants further submit that each of Pursley and McKay fails to disclose or suggest the combination of elements recited in claims 1-13. Thus, these claims are allowable over these references. Applicants, therefore, respectfully request the reconsideration and withdrawal of the Section 103(a) rejections of these claims. Applicants further request reconsideration of the application, and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 03-2775. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be

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charged to our Deposit Account.

Respectfully submitted,

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